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IN THE

**Supreme Court of the United States**

**No. 441**

**October Term, 1938.**

**THE ELECTRIC STORAGE BATTERY CO.,**

*Petitioner,*

*v.*

**GENZO SHIMADZU and NORTHEASTERN  
ENGINEERING CORPORATION,**

*Respondents.*

**Petition for a Writ of Certiorari and Brief  
in Support Thereof.**

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## INDEX.

	Page
<b>SUMMARY STATEMENT OF MATTER INVOLVED</b>	1
<b>REASONS RELIED ON FOR ALLOWANCE OF THE WRIT</b> .....	7
<b>BRIEF IN SUPPORT OF PETITION</b> .....	9
I. The Opinions of the Courts below .....	9
II. Jurisdiction .....	9
III. Statement of the Case .....	10
IV. Specification of Errors .....	10
<b>ARGUMENT</b> .....	13
Summary of Argument .....	13

Point I. In holding that in the ascertainment, under the Patent Statutes of the United States, of the date of an invention made abroad, such Statutes do not proscribe all evidence of invention abroad other than that derived from patents, printed publications, or patent applications within the terms of R. S. 4887, the Court below has decided an important question of Federal Law which has not been, but should be, settled by this Court. . . 13

Point II. In holding that United States Patents are not invalidated by commercial use by others in this country, of the inventions patented, for more than two years before the actual filing of the applications for such patents, the Court below has decided a Federal question in a way probably in conflict with applicable decisions of this Court, as well as of another Circuit Court of Appeals. . . . 21

## INDEX—Continued.

Page

Point III. In holding valid a United States Patent granted to one who had made an invention in a foreign country, but who withheld and suppressed it for a long period of time and did not file an application for a United States Patent therefor until more than two years after the thing subsequently patented had been brought into commercial use by others in this country, the Courts below decided an important question of Federal law in a way probably in conflict with an applicable decision of this Court .....

23

CONCLUSION .....

25

APPENDIX .....

27

## TABLE OF CASES.

	Page
Appliance Co. v. Equipment Co., 297 U. S. 387, 392...	9
Badische Anilin & Sode Fabrik v. A. Klipstein & Co., 125 Fed. 543 .....	19
Bell v. Brooks, 19 O. G. 290, C. D. (1881) 4.....	14, 15
Brush v. Condit, 132 U. S. 39, 49.....	22
Brush Electric Co. v. Julien Electric Co., 41 Fed. 679, 686 .....	17
Carr v. Davids, 3 O. G. 440, C. D. (1873) 79.....	14
Chambers v. Duncan, 9 O. G. 741 .....	14
Claude Neon Lights Co. v. Rainbow Light, 47 Fed. (2d) 345 .....	19
DeKando v. Armstrong, 37 App. D. C. 314, 321.....	14
Douglas v. Cunningham, 294 U. S. 207, 209.....	10
Egbert v. Lipman, 104 U. S. 333 .....	22
Electrical Accumulator Co. v. Brush Electric Co., 52 Fed. 130, 134 (C. C. A. 2).....	17
Electrical Accumulator Co. v. Julien Elec. Co., 38 Fed. 117 .....	17
Gandy v. Main Belting Co., 143 U. S. 578 .....	18
Gayler v. Wilder, 10 How. 477, 496.....	18
Grant et al. v. Raymond, 6 Pet. 218, 243.....	18
Hall v. Shimadzu, 59 Fed. (2d) 225.....	5
Hanifen v. E. H. Godshalk, 78 Fed. 811 .....	19
Hanifen v. Price, 96 Fed. 435 .....	19
Hovey v. Hufeland, 2 O. G. 493 .....	14
Ireson v. Pierce, 39 Fed. 795, 798 .....	17
Jay v. Weinberg, 250 Fed. 469, 472 .....	17
Keller v. Adams-Campbell Co., 264 U. S. 314.....	9
Kendall v. Winsor, 21 How. 322, 327.....	18, 20, 24
Lauder v. Crowell, 16 O. G. 405 .....	14
Lorimer v. Erickson, 227 O. G. 1445 .....	14

## TABLE OF CASES—Continued.

	Page
Manning v. Cape Ann Isinglass & Glue Co., 108 U. S. 462 .....	22
N. Y. Life Ins. Co. v. Viglas, 297 U. S. 672, 676 .....	10
Patents Selling & Exporting Co. v. Dunn, 213 Fed. 40 ..	17
Prudence Co. v. Fidelity Co., 297 U. S. 198, 205 .....	10
Rebuffat v. Crawford, 68 Fed. (2d) 980, 982 .....	14
Smith v. Barter, 7 O. G. 1, C. D. (1875) 5, 7, 8 .....	14, 15
Thomas v. Reese, 17 O. G. 195 .....	14
Triplett v. Lowell, 297 U. S. 638, 639 .....	9
Tucker v. Davis, 2 O. G. 224 .....	14, 15
Twyman v. Radiant Glass Co., 56 Fed. (2d) 119, 121 ..	22
Vacuum Engineering Co. v. Dunn, 209 Fed. 219 (CCA 2) .....	17
Welsbach Light Co. v. American Incandescent Lamp Co., 98 Fed. 613 .....	19
Westinghouse Mach. Company v. General Electric Co., 207 Fed. 75, 78 .....	17
Wilson v. Sherts, 81 Fed. (2d) 755, 760 .....	14, 16

## STATUTES CITED.

	Page
R. S. 4886 (See Appendix) .....	6, 13, 15, 19, 20, 21
R. S. 4887 (See Appendix) .....	6, 7, 11, 13, 14, 15, 16, 19, 21
R. S. 4920 (See Appendix) .....	13, 17
R. S. 4923 (See Appendix) .....	13, 17
R. S. 4915 .....	17
Section 240(a) of the Judicial Code as amended by Act of February 13, 1925 (28 U. S. C. § 347(a)) ..	9

IN THE  
Supreme Court of the United States.

No.                      October Term, 1938.

THE ELECTRIC STORAGE BATTERY CO.,  
*Petitioner,*

v.

GENZO SHIMADZU AND NORTHEASTERN ENGI-  
NEERING CORPORATION,  
*Respondents.*

Petition for a Writ of Certiorari.

*To the Honorable the Chief Justice of the United States  
and the Associate Justices of the Supreme Court of the  
United States:*

Petitioner, The Electric Storage Battery Co., respectfully prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Third Circuit to review a judgment of that Court filed on August 8, 1938, rehearing denied September 14, 1938, affirming the decree of the United States District Court for the Eastern District of Pennsylvania (Kirkpatrick, J.).

**SUMMARY STATEMENT OF MATTER INVOLVED.**

This is an infringement suit in equity upon six United States Patents\* granted to Genzo Shimadzu, a subject of the Emperor of Japan and a resident of Japan.

*Patent	Claims	Application Filed		Patent Issued	
1,584,149	1-2	Jan.	30, 1922	May	11, 1926
1,584,150	1-4, 6, 8-17	July	14, 1923	May	11, 1926
1,584,151	1-5	Apr.	18, 1924	May	11, 1926
1,584,152	1-2	Apr.	18, 1924	May	11, 1926
1,584,479	1-4	Feb.	20, 1923	May	11, 1926
1,896,020	10-11	Apr.	27, 1926	Jan.	31, 1933



*Summary Statement of Matter Involved*

The parties plaintiff are Shimadzu, as owner of the patents, and Northeastern Engineering Corporation, as exclusive licensee.

Defendant is The Electric Storage Battery Company, petitioner herein.

By its decree, the United States District Court for the Eastern District of Pennsylvania (Kirkpatrick, J.) adjudged (R. II, 1192)

<i>Patent</i>	<i>Claims</i>	<i>Decree</i>
1,584,149	1-2	valid and infringed,
1,584,150	1-4, 6, 8-13	valid and infringed,
1,896,020	10-11	valid and infringed.

The remaining claims in issue were adjudged valid but not infringed.

Both parties appealed to the Circuit Court of Appeals for the Third Circuit. The decree of the District Court was affirmed (R. II, 1226) upon the opinion of the District Court (R. II, 1225).

A petition for rehearing was filed by petitioner and denied by the Circuit Court of Appeals September 14, 1938. (R. II, 1255).

This petition pertains only to the claims held valid and infringed.

The claims here involved of Patents No. 1,584,149 and No. 1,584,150\* have to do with the production of a fine powder of lead by the abrasion of larger pieces of metallic lead

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\*The Courts below found that the process of patent No. 1,584,149 differed from that of patent 1,584,150 in that the process of the former is carried out at room temperature and air is introduced into the mill to remove the powder from the mill, while in the latter, the process is carried out at elevated temperatures and air is introduced into the mill for oxidation purposes (R. II, 1166-7).

in a dry state in a rotating mill under specified conditions. The claims here involved of patent No. 1,896,020 are for apparatus for carrying out the process. The product, "lead dust," is used in the manufacture of plates for storage batteries (R. II, 1162).

The inventions of these patents were made by Shimadzu in Japan. (R. II, 1163).

The dates upon which he filed his applications for the patents in suit and the dates of their grant, were:

<i>Patents</i>	<i>Applied for</i>	<i>Granted</i>
1,584,149	Jan. 30, 1922	May 11, 1926
1,584,150	July 14, 1923	May 11, 1926
1,896,020	Apr. 27, 1926	Jan. 31, 1933

Shimadzu has no foreign patent for the same invention as his patent No. 1,896,020. The Courts below found that he had no foreign patent equivalent to his patent No. 1,584,149.

Japanese patent No. 60,825 to Shimadzu issued June 19, 1924. It was applied for February 3, 1923, which was within twelve months of the filing, on July 14, 1923, of application for United States patent No. 1,584,150.

The Courts below found (R. II, 1172) that it

"corresponds very closely with U. S. '150."

Petitioner contended that Japanese patent No. 42,563, applied for November 27, 1920, and granted May 10, 1922, was for the same invention as that of patent in suit, No. 1,584,150, which was applied for July 14, 1923, and whose reduction to practice in Japan the Courts below found was in August 1919. In denying this contention of petitioner, the Courts below said (R. II, 1172):

*Summary Statement of Matter Involved*

"For whatever it may be worth, it is pretty clear that the plaintiff himself did not understand that, when he applied for Japanese '563, he was taking out a patent on the same process which appears in U. S. '150, because subsequently, in Japan, he took another patent, No. 60,825, which corresponds very closely with U. S. '150, and, being within the year, does not invalidate it. *We are not concerned with the motives which prompted him, in taking out the '563 patent, to confine it to a single step of mechanical removal of the dust from the drum, and to withhold the really essential steps of the invention for later patenting. It is sufficient to say that he had the right to do this if he chose.*" \*

Shimadzu made no disclosure of his inventions to anyone in the United States before he filed his applications for his United States patents. His inventions were not patented or described in any printed publication in this or any foreign country, prior to the filing of his application for the patents in suit.

The defenses included (1) prior knowledge and use by others in this country before Shimadzu's invention; (2) that Shimadzu was not the first inventor of the thing patented, and (3) public use in this country for more than two years prior to the filing of the application for patent No. 1,584,150 (R. I, 34, 35).

Petitioner is the manufacturer of the "EXIDE" batteries. It has been engaged in manufacturing storage batteries in Philadelphia since the latter part of the last century.

Its employees were leaving from time to time. At the trial plaintiffs called as their witness, one Cooper, a for-

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\*Italics throughout petition and brief are counsel's, unless otherwise indicated.

mer employee of petitioner, to describe petitioner's process and apparatus (R. I, 401).

Petitioner has used the same process, and Hardinge Mills for carrying out its process, since early in 1921.

The Courts below found, (R. II, 1192):

“It is therefore plain that there is no evidence of anything beyond an experimental use by the defendant earlier than about the middle of the year 1921. . . . *Commercial production* (by petitioner)\* by the Hardinge Mill with its forced air draft undoubtedly involved the use of the plaintiff's patent, and June 1921 may be fixed as the date when that began.”\*\*

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\*Parenthetical expressions throughout petition and brief are counsel's.

\*\*The Hardinge Mill was installed and operated under the direction of Mr. C. A. Hall, who was employed therefor by petitioner. In March 1924, Mr. Hall applied for a patent for the apparatus which eventuated in patent to Hall No. 1,675,345 (PX 17). In March 1924, Mr. Hall also filed an application for the Hardinge Mill process which included rumbling lead balls in a rotating mill in the presence of air currents and a controlled elevated temperature, and this application eventuated in patent to Hall 1,888,823 (PX 18).

While the Hall application was pending, Shimadzu's patent 1,584,150 issued. Hall believed the processes of his application and Shimadzu's patent to be identical and added claims 2, 3, 4, 6, 9 to 17 inclusive from patent 1,584,150 to his application. An interference was declared. The Law Examiner held claims 9 to 13 inclusive unpatentable. The Board of Appeals of the Patent Office and the Court of Customs and Patent Appeals (Hall v. Shimadzu, 59 Fed. 2d, 225) awarded priority with respect to the remaining claims to Shimadzu upon the ground that an essential ingredient of those claims is suboxide of lead, and that Hall's process did not produce suboxide of lead. As a consequence, Hall's patent issued without those claims. The Courts below held that the process developed by Hall and used by petitioner commercially since June 1921, infringes claims 1 to 4, 6, 8 to 13 of Shimadzu's patent 1,584,150. (R. II, 1174-1175, 1177-1178, 1194).

June 1921, not only antedated all the patents in suit, all the United States applications therefor, the application for Japanese patent 60,825, any description in any printed publications, any foreign patents and any disclosure in this country by Shimadzu of the inventions patented in the patents in suit; but June 1921 was, as well,

“more than two years before the date of the actual filing of the application in this country”. (RS 4887).

for patent No. 1,584,150, and

“more than two years prior to his application” (RS 4886).

for patent No. 1,896,020.

But, over the objection of petitioner, (R. I, 140), plaintiffs were permitted to adduce evidence for the purpose of showing that Shimadzu conceived and reduced the inventions to practice in Japan and the date thereof.

Upon such evidence, consisting of oral testimony, drawings and purported copies of alleged note book entries, the Courts below found, (R. II, 1166):

“I fix the date of invention and successful reduction to practice (In Japan) as not later than August 1919.”

At R. II, 1178, the Courts below held:

“The plaintiff is undoubtedly entitled to rely for priority upon the date of invention and reduction to practice as found, *regardless of the fact that the invention was made in a foreign country.*”

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The Court of Customs and Patent Appeals gave to Shimadzu as the date of his invention the date of his application. The Courts below permitted him to show conception and reduction to practice in Japan and gave him the date of August 1919.

**REASONS RELIED ON FOR ALLOWANCE OF THE WRIT.**

The discretionary power of this Court to grant the writ of certiorari is invoked upon the following grounds:

(1) In holding that in the ascertainment, under the Patent Statutes of the United States, of the date of an invention made abroad, such Statutes do not proscribe all evidence of invention abroad other than that derived from patents, printed publications, or patent applications within the terms of R. S. 4887, the Court below has decided an important question of federal law which has not been, but should be, settled by this Court.

(2) In holding that United States patents are not invalidated by commercial use by others in this country, of the inventions patented, for more than two years before the actual filing of the applications for such patents, the Court below has decided a federal question in a way probably in conflict with applicable decisions of this Court, as well as of another Circuit Court of Appeals.

(3) In holding valid a United States patent granted to one who had made an invention in a foreign country, but who withheld and suppressed it for a long period of time and did not file an application for a United States patent therefor until more than two years after the thing subsequently patented had been brought into commercial use by others in this country, the Court below decided an important question of federal law in a way probably in conflict with an applicable decision of this Court.

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued out of and under the seal of

this Court, directed to the United States Circuit Court of Appeals for the Third Circuit, commanding said Court to certify and send to this Court, on a day to be designated, a full transcript of the record of all proceedings of the said Circuit Court of Appeals in the case numbered and entitled on its docket "No. 6309, The Electric Storage Battery Co. v. Genzo Shimadzu and Northeastern Engineering Corporation", to the end that this case may be reviewed and determined by this Court; that the judgment of the said Circuit Court of Appeals for the Third Circuit be reversed and that petitioner be granted such other and further relief as to this Honorable Court may seem meet and proper.

THE ELECTRIC STORAGE  
BATTERY CO.,

*Petitioner.*

By AUGUSTUS B. STOUGHTON,

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# Brief in Support of Petition.

## I.

### THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court (R. II, 1162) is reported in 17 Fed. Supp. 42.

The opinion of the Circuit Court of Appeals (R. II, 1223) has not been officially reported.

## II.

### JURISDICTION.

(a) The date of the judgment or decree of the Court below was August 8, 1938 (R. II, 1226).

Rehearing was denied by the Court below September 14, 1938 (R. II, 1255).

(b) The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C. § 347(a)).

(c) Cases believed to sustain the jurisdiction of this Court are:

With respect to "Reason" (1):

*Keller v. Adams-Campbell Co.*, 264 U. S. 314, 318, 319;

*Appliance Co. v. Equipment Co.*, 297 U. S. 387, 392;

*Triplett v. Lowell*, 297 U. S. 638, 639.



With respect to "Reasons" (2) and (3):

*Douglas v. Cunningham*, 294 U. S. 207, 209;  
*Prudence Co. v. Fidelity Co.*, 297 U. S. 198, 205;  
*N. Y. Life Ins. Co. v. Viglas*, 297 U. S. 672, 676.

### III.

#### STATEMENT OF THE CASE.

The attention of the Court is respectfully directed to the petition, which contains a statement of the facts of the case here pertinent. In the interest of brevity, the facts will not here be repeated.

### IV.

#### SPECIFICATION OF ERRORS.

The Circuit Court of Appeals for the Third Circuit erred in the instant case,

(1) In holding that "the plaintiff is undoubtedly entitled to rely for priority upon the date of invention and reduction to practice as found, regardless of the fact that the invention was made in a foreign country."

(2) In not holding that one who has made an invention in a foreign country and obtained a patent therefor in this country may not, for the purpose of overcoming the defenses of prior knowledge and use in this country and that the patentee is not the first inventor, carry back the date of the invention to the actual time of invention in the foreign country.

(3) In holding that the date of the invention of the claims, held valid and infringed, of the patents in suit was not later than August 1919.

(4) In not holding that the patent statutes of the United States proscribe all evidence of invention abroad other than that derived from patents, printed publications, or patent applications within the terms of R. S. 4887.

(5) In not holding that testimony with respect to experiments and reduction of an invention to practice in foreign countries is incompetent and inadmissible under the patent statutes of the United States, to establish the date of invention of the thing patented or sought to be patented in this country.

(6) In not holding that under the patent statutes, the date of an invention made and first patented in a foreign country and thereafter in the United States upon a timely application, is the date of the application for the foreign patent.

(7) In not holding that the claims, adjudged valid and infringed, are invalid because the things patented were known and used by others in this country before the invention or discovery thereof by Shimadzu within the meaning of the patent statutes.

(8) In not holding that the claims, adjudged valid and infringed, are invalid because Shimadzu was not the first inventor.

(9) In not holding that the claims of Patents Nos. 1,584,150 and 1,896,020, adjudged valid and infringed, are invalid because the process and apparatus of said claims were in public used in this country for more than two years prior to the actual filing of the applications for said patents in this country.

(10) In not holding that the claims of Patents Nos. 1,584,150 and 1,896,020, adjudged valid and infringed, are in-

valid because the inventions of said claims were suppressed and concealed by Shimadzu for more than two years after the subject-matter of the said claims had been known and used commercially in this country.

(11) In holding any of the claims of any of the patents in suit valid and infringed and in granting respondents an injunction and an accounting.

## Argument.

### SUMMARY OF ARGUMENT.

The points of the argument coincide with the reasons relied on for allowance of the writ (P. p. 7). For the sake of brevity they are not repeated at this point.

#### Point I.

**In Holding That in the Ascertainment, under the Patent Statutes of the United States, of the Date of an Invention Made Abroad, Such Statutes Do Not Proscribe All Evidence of Invention Abroad Other Than That Derived from Patents, Printed Publications, or Patent Applications Within the Terms of R. S. 4887, the Court Below Has Decided an Important Question of Federal Law Which Has Not Been, But Should Be, Settled by This Court.**

The question thus decided by the Courts below involves the construction of the Patent Statutes of the United States, and particularly, R. S. 4886, 4887, 4920 and 4923,\* as applied to the determination of the time when, and the acts by which, an inventor, who made his invention in a foreign country, brings his invention within the cognizance and operation of those Statutes.

The process and apparatus known and used commercially in Philadelphia by petitioner in June, 1921 were held by the Courts below to be infringements of plaintiffs' patents Nos. 1,584,149, 1,584,150 and 1,896,020. It would therefore seem manifest that all the claims of said patents held valid and infringed are invalid, because the inventions there-

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\*For convenient reference, these sections are set out in an appendix hereto.

of were known and used by others in this country before Shimadzu's invention or discovery thereof, unless Shimadzu can take the date of his invention back of June 1921.

Shimadzu's inventions were made in Japan. In June 1921 his inventions had not been described in any printed publication anywhere. No application for patent therefor has been filed in any country. His inventions had not then been disclosed to any person in this country, and were not so disclosed at any time prior to the filing of applications therefor in this country, long after June 1921.

Thus arises the naked question of law—whether the patent statutes of the United States permit or proscribe evidence of invention abroad other than that derived from patents, printed publications, or patent applications within the terms of R. S. 4887, to ascertain the date of an invention made abroad.\*

For far more than half a century, the Patent Office and the Courts of the District of Columbia having appellate jurisdiction over the final decisions of the Patent Office have ruled in interference proceedings in an unbroken line of cases,<sup>1</sup> that unless and until inventions made abroad are

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\*The cases hereinafter referred to are cited and discussed for the purpose of showing the various ways in which the statutes have been construed and that the resulting confusion should be dissipated and the proper construction of the statutes settled by a decision of this Court.

<sup>1</sup> Tucker v. Davis, 2 O. G. 224; Hovey v. Hufeland, 2 O. G. 493; Carr v. Davids, 3 O. G. 440, C. D. (1873) 79; Smith v. Barter, 7 O. G. 1, C. D. (1875) 5, 7, 8; Chambers v. Duncan, 9 O. G. 741, C. D. (1876) 82; 10 O. G. 787, C. D. (1876) 223; Lauder v. Crowell, 16 O. G. 405, C. D. (1879) 177; Thomas v. Reese, 17 O. G. 195, C. D. (1879) 335; Bell v. Brooks, 19 O. G. 290, C. D. (1881) 4; DeKando v. Armstrong, 37 App. D. C. 314, 321, 169 O. G. 1185, C. D. (1911) 413; Lorimer v. Erickson, 227 O. G. 1445, 44 App. D. C. 503; Rebuffat v. Crawford, 68 Fed. (2d) 980, 982; Wilson v. Sherts, 81 Fed. (2d) 755, 760.

made accessible to the American public in ways provided by the statutes, they are not within the cognizance of the patent statutes and that such foreign inventions can be made so accessible, in the absence of actual disclosure in this country, only through the disclosure thereof in a foreign patent (R. S. 4886), in a printed publication in this or any foreign country (R. S. 4886), or, in a case falling within the purview of R. S. 4887, in an application filed abroad.

Construing R. S. 4886, it was held in *Bell v. Brooks*, 19 O. G. 290, C. D. (1881) 4, as stated in the syllabus:

“Testimony in reference to experiments and reduction to practice in foreign countries, whether the invention be that of an American citizen or foreigner, is incompetent and inadmissible, the Revised Statutes of the United States proscribing all other evidence of invention abroad than that derived from patents or printed publications.”

It was said by the Commissioner of Patents in *Smith v. Barter*, 7 O. G. 1, C. D. (1875) 5, 7, that to admit evidence of conception and actual reduction to practice in a foreign country would upset “the long established practice of the Office.”

The reason for the construction adopted was stated in the case of *Tucker v. Davis*, 2 O. G. 224 thus:

“A device existing in a foreign country, unless it has been patented or described in a printed publication, so that there is no reasonable probability that it may be known here, is of no benefit to the public of this country. The law proceeds altogether upon the ground that the inventor confers a benefit on the public here, and it specially encourages and protects him for that reason. A foreign inventor, whether a citizen of the United States or not is immaterial, can only

benefit the public here by publishing his invention here. The original inventor first to produce his invention in this country, either by inventing it here or by bringing it with him from abroad, is the first to have done an act capable of working a benefit to the public here, and the one to be rewarded by a patent. It follows that evidence of any act not coming within the limitation would not be pertinent to an issue upon a question of priority of invention and should not be admitted."

Prior to the Amendment of R. S. 4887, by the Act of March 3, 1903, 32 Stat. 1225, giving to an application, filed in this country within twelve months of the filing in a foreign country of an application for patent for the same invention, the same force and effect as the application in this country would have if filed on the date of filing of the foreign application, the only evidence of invention in a foreign country admissible in the Patent Office and in the Courts of Appeal for the District of Columbia, was that derived from prior issued patents in a foreign country or printed publications in this or any foreign country.

Since the Amendment of R. S. 4887 in 1903, the tribunals of the Patent Office and the Court of Appeals of the District of Columbia have modified the pre-existing rule in accordance with the terms of that Amendment, but only to the extent of permitting a foreign inventor to establish the date of his foreign invention by his foreign application in cases falling strictly within the terms of the Amendment.

Thus, in *Wilson v. Sherts*, 81 Fed. (2d) 755, 760, 761, the Court of Customs and Patent Appeals said:

"The right of a party to have the benefit of the filing date of a foreign application for a patent as a constructive reduction to practice is purely statutory. Without the benefit of said section 4887, R. S., appel-



lants would not be entitled to consideration of their British provisional application at all. It seems to us that the right of the appellants to the benefit of their activities abroad must be found within the four corners of this statute, and the only right thus granted is the benefit of the filing date of the foreign application."

In suits under R. S. 4915, 35 U. S. C. § 63, the patent statutes have been interpreted in like manner by the inferior courts.<sup>2</sup>

In infringement suits the statutes have been given the same construction in the determination of priority between the foreign inventor plaintiff and a third person who made the same invention in this country which was subsequently patented.<sup>3</sup>

The same construction of the patent statutes has been applied generally by some of the Courts in patent infringement suits.

Thus, in *Ireson v. Pierce*, 39 Fed. 795, 798, Circuit Judge Coff said:

"Under §§ 4886, 4920, 4923, Rev. St., the *only* evidence that can be used in proof of a foreign invention for any purpose is that coming through the channel of a patent or printed publication."

In *Jay v. Weinberg*, 250 Fed. 469, 472, which involved the question of priority of invention coming within the terms of R. S. 4887, as amended in 1903, the Court said:

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<sup>2</sup> *Westinghouse Mach. Company v. General Electric Company*, 207 Fed. 75, 78.

<sup>3</sup> *Electrical Accumulator Co. v. Julien Electric Co.*, 38 Fed. 117, 128; *Brush Electric Co. v. Julien Electric Co.*, 41 Fed. 679, 686; *Electrical Accumulator Co. v. Brush Electric Co.*, 52 Fed. 130, 134, (C. C. A. 2); *Vacuum Engineering Co. v. Dunn*, 209 Fed. 219 (C. C. A. 2); *Patents Selling & Exporting Co. v. Dunn*, 213 Fed. 40 (C. C. A. 2).



"The foreign application date is therefore the effective date of this patent."

The foregoing decisions seem to be in harmony with the broad purpose, object and spirit of the patent statutes as declared in the decisions of this Court.\*

In *Gayler v. Wilder*, 10 How. 477, 496, Mr. Chief Justice Taney, speaking for the Court, said:

"... by knowledge and use the legislature meant knowledge and use existing in a manner accessible to the public. If the foreign invention had been printed or patented, it was already given to the world and open to the people of this country, as well as of others, upon reasonable inquiry. They would therefore derive no advantage from the invention here. It would confer no benefit upon the community, and the inventor therefore is not considered to be entitled to the reward. But if the foreign discovery is not patented, nor described in any printed publication, it might be known and used in remote places for ages, and the people of this country be unable to profit by it. The means of obtaining knowledge would not be within their reach; and, as far as their interest is concerned, it would be the same thing as if the improvement had never been discovered. It is the inventor here that brings it to them, and places it in their possession. And as he does this by the effort of his own genius, the law regards him as the first and original inventor, and protects his patent, although the improvement had in fact been invented before, and used by others."

In *Gandy v. Main Belting Co.*, 143 U. S. 578, this Court held that two years public use of the invention abroad was

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\* *Grant, et al. v. Raymond*, 6 Pet. 218, 243; *Kendall v. Winsor*, 21 How. 322, 327-328; *Gayler v. Wilder*, 10 How. 477, 496-497; *Gandy v. Main Belting Co.*, 143 U. S. 578.

not a bar to a patent, notwithstanding R. S. 4886 did not then expressly provide that such use, to be a bar, should be "in this country".

Some of the inferior Courts, including the Courts below, however, overlooking, it is believed, that no acts abroad other than patents, printed publications, and patent applications within the purview of R. S. 4887, are within the contemplation of the patent statutes, and disregarding the purpose, object and spirit of those statutes have held, in patent infringement suits based on patents for inventions made in a foreign country, that the patentee may carry back the date of the invention, as against knowledge and use in this country by a non-patentee defendant, to the actual date thereof in the foreign country.<sup>5</sup>

Such construction makes the right of a foreign inventor to carry back the date of his invention to the actual date thereof in a foreign country, turn upon whether his adversary has, or is seeking, a patent monopoly. If he has a patent for an invention made in this country or has applied for a patent for an invention made in this country, the date of the invention abroad may not be carried back of the date of its disclosure in this country, otherwise than by prior foreign patent therefor, by description of the invention in a printed publication, or by the filing of an application for a foreign patent meeting the requirements of R. S. 4887. If, however, the adversary is not seeking, or has not obtained a patent monopoly for himself but is a member of the general public engaged in commercial pro-

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<sup>5</sup> Hanifen v. E. H. Godshalk, 78 Fed. 811; Hanifen v. Price, 96 Fed. 435; Welsbach Light Co. v. American Incandescent Lamp Co., 98 Fed. 613; Badische Anilin & Soda Fabrik v. A. Klipstein & Co., 125 Fed. 543; Claude Neon Lights Co. v. Rainbow Light, 47 Fed. (2d) 345.

duction, the foreign inventor may, under such decisions, carry back, by oral testimony, the date of his invention to the actual date of invention in a foreign country. It is difficult to find either in the letter or spirit of the patent statutes a justification for an interpretation that makes possible such distinction to the detriment of the general public, and particularly to those thereof engaged in commercial production, and to the advantage of those who seek or have a patent monopoly.

Under the very terms of R. S. 4886, the question whether an inventor is the *first inventor* is made to turn upon whether the thing invented was known or used in this country before the date of invention to which, under the statutes, the inventor is entitled. *That issue does not turn upon whether the thing so known or used in this country is patented, or upon whether an application for a patent therefor has been filed.*

*Kendall v. Winsor*, 21 How. 322, 328.

It is believed that neither the letter nor the spirit of the patent statutes warrants the construction placed upon them by the decision of the Courts below.

Because of the character of the question involved, the long-existing conflict between the decisions of the Patent Office and the Court of Customs and Patent Appeals on the one hand, and the decisions of inferior Courts, including the Courts below, on the other, as to the true construction of the patent statutes touching the date of an invention made abroad and the question of priority between one who makes an invention abroad and another who uses the same thing in this country, presents a legal bewilderment upon an issue of broader public concern, it is believed, than that which arises when Circuit Courts of Appeals dif-

fer with respect to the construction or validity of a single patent.

It is suggested that the question of the true construction of the patent statutes touching the date of an invention made abroad is one of fundamental importance, one that affects the public generally, and one that should be settled by this Court.

## POINT II.

**In Holding That United States Patents Are Not Invalidated by Commercial Use by Others in This Country, of the Inventions Patented, for More Than Two Years Before the Actual Filing of the Applications for Such Patents, the Court Below Has Decided a Federal Question in a Way Probably in Conflict With Applicable Decisions of This Court, as Well as of Another Circuit Court of Appeals.**

The Courts below found that petitioner began, in June 1921, commercial use of the inventions of the claims found valid and infringed. (R. II, 1192).

Shimadzu's application for patent No. 1,584,150 was filed July 14, 1923. His application for patent No. 1,896,020 was filed April 27, 1926.

The filing date of each application was more than two years after June 1921.

Both R. S. 4886 and R. S. 4887 in express terms constitute a bar to a patent if the invention thereof has been in public use in this country for more than two years prior to the filing of the application for such patent in the United States.

Petitioner's use from June 1921 was a commercial use. It was not experimental. (R. II, 1192). Respondents' rec-

ognizing that petitioner's employees have not been pledged to secrecy, called as a witness in their prima facie case, one of petitioner's former employees, to describe the process and apparatus used by petitioner (R. I, 401). His testimony covered the period beginning in June 1923 and ending in 1930 (R. I, 401). The decision of the Court below is thus probably in conflict, it is believed, with the decisions of this Court in *Egbert v. Lippman*, 104 U. S. 333; *Brush v. Condit*, 132 U. S. 39, 49; and *Manning v. Cape Ann Isinglass & Glue Co.*, 108 U. S. 462.

Such decision of the Court below likewise appears to be in conflict with the decision of the Circuit Court of Appeals for the Eighth Circuit in *Twyman v. Radiant Glass Co.*, 56 Fed. (2d) 119, 121.\* In that case the patent was for a mold for glass cylinders. In holding the patent invalid because of defendant's public use of the invention thereof for more than two years prior to the date of plaintiff's application, the Court said:

"There is nothing in the record to sustain plaintiff's contention that the art of making glass molds was in the experimental stage at the time he entered the field. For more than two years prior to that time defendant had been using the accused device in the manufacture of these molds commercially and in sub-

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\*This decision would be set up as a separate and distinct reason for granting the writ of certiorari upon the ground that the decision of the Court below is in conflict therewith on the same matter were it not for the fact that the District Court in the *Twyman* case found "that the device manufactured and sold by the appellee was in public use for more than two years prior to the date of appellant's application for patent." (56 Fed. (2d) 120.) By reason of that difference, though apparently without substance, counsel are unwilling to certify that the two cases are in conflict, "on the same matter".

stantial numbers for sale to the public. They were being so manufactured *for the purposes of the trade and for profit*. There is nothing to indicate that they were being manufactured for experimental purposes, but, if used mainly for purposes of trade, and incidentally as an experiment, the use would still be a public one."

### Point III.

**In Holding Valid a United States Patent Granted to One Who Had Made an Invention in a Foreign Country, But Who Withheld and Suppressed It for a Long Period of Time and Did Not File an Application for a United States Patent Therefor Until More Than Two Years After the Thing Subsequently Patented Had Been Brought into Commercial Use by Others in This Country, the Courts Below Decided an Important Question of Federal Law in a Way Probably in Conflict with an Applicable Decision of This Court.**

The Courts below found that the invention of Patent No. 1,584,150 was made in Japan in August 1919. (R. II, 1166.)

The Courts below likewise found that, notwithstanding Shimadzu filed applications for Japanese patents in November 1920, he withheld "the really essential steps of the invention for later patenting". (R. II, 1172, 1225.)

Shimadzu did not file his applications for United States patents Nos. 1,584,150 and 1,896,020 until July 14, 1923 and April 27, 1926, respectively. The date on which each of those applications was filed was more than two years after June 1921, the date upon which the Courts below have found that petitioner began its commercial use, by the Hardinge Mill, of Patent 1,584,150 (R. II, 1192).

The Courts below likewise found (R. II, 1172),



"We are not concerned with the motives which prompted him in taking out the '563 patent to confine it to the single step of mechanical removal of the dust from the drum and to withhold the really essential steps of the invention for later patenting. It is sufficient to say that he had the right to do this if he chose."

It is suggested that by so finding, the Courts below decided a Federal question in a way probably in conflict with an applicable decision of this Court. That decision is *Kendall v. Winsor*, 21 How. 322, 328. This Court there said:

"By correct induction from these truths, it follows, that the inventor who designedly, and with the view of applying it indefinitely and exclusively for his own profit, withholds his invention from the public, comes not within the policy or objects of the Constitution or acts of Congress. He does not promote, and, if aided in his design, would impede, the progress of science and the useful arts. And with a very bad grace could he appeal for favor or protection to that society which, if he had not injured, he certainly had neither benefitted nor intended to benefit. Hence, if, during such a concealment, an invention similar to or identical with his own should be made and patented, or brought into use without a patent, the latter could not be inhibited nor restricted, upon proof of its identity with a machine previously invented and withheld and concealed by the inventor from the public. The rights and interests, whether of the public or of individuals, can never be made to yield to schemes of selfishness or cupidity; moreover, that which is once given to or is invested in the public, cannot be recalled nor taken from them."

**CONCLUSION.**

For the foregoing reasons, it is believed that this Court should be moved to grant the writ of certiorari to the end that the fundamental questions of patent law here involved may be settled by this Court and the judgment of the Court below reversed.

Respectfully submitted,

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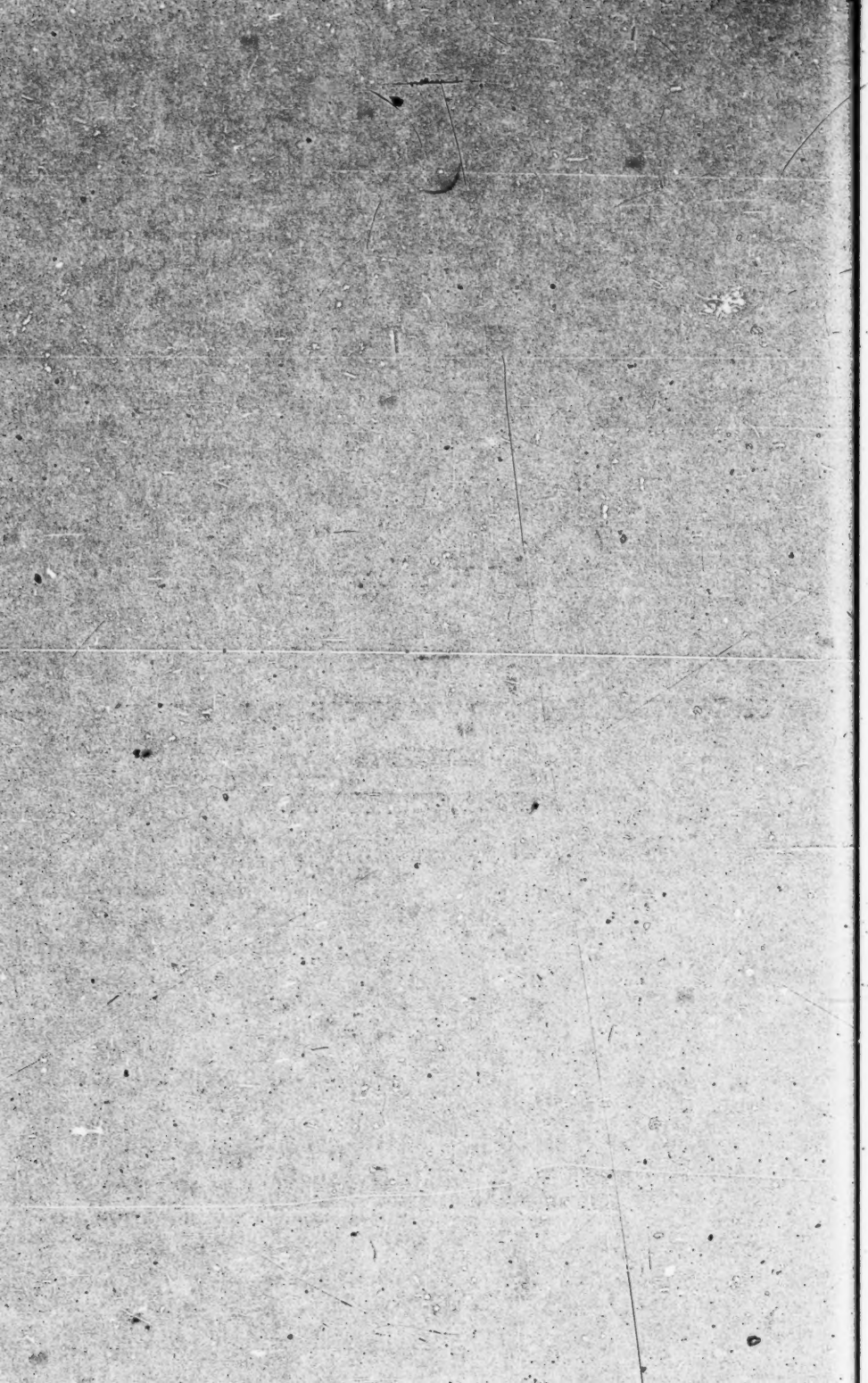


**Appendix.**

**CONTAINING REVISED STATUTES 4886, 4887, 4920  
AND 4923**

**BEING RESPECTIVELY**

**§§ 31, 32, 69 and 72 of Title 35 U. S. C.**



**RS4886**

“Section 31. *Inventions patentable.* Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others *in this country*, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. (R. S. § 4886; Mar. 3, 1897, c. 391, § 1, 29 Stat. 692.)”

**RS4887**

“§32. *Inventions previously patented abroad.* No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section 31 of this title, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

“An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design

in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section 31 of this title, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing. (R. S. § 4887; Mar. 3, 1897, c. 391, § 3, 29 Stat. 693; Mar. 3, 1903, c. 1019, § 1, 32 Stat. 1225.)”

**RS4920**

“§ 69. *Pleading and proof in actions for infringement.* In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney thirty days before, may prove on trial any one or more of the following special matters:

“First. That for the purpose of deceiving the public the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect: or,

“Second. That he had surreptitiously or unjustly obtained the patent for that which was in fact invented

by another, who was using reasonable diligence in adapting and perfecting the same; or,

“Third. That it has been patented or described in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

“Fourth. That he was not the original and first inventor or discoverer or\* any material and substantial part of the thing patented; or,

“Fifth. That it had been in public use or on sale in this country for more than two years before his application for a patent, or had been abandoned to the public.

“And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect. (R. S. § 4920; Mar. 3, 1897, c. 391, § 2, 29 Stat. 692).”

#### RS4923

“§ 72. *Patent not void for previous use of thing in foreign country.* Whenever it appears that a patentee, at the time of making his application for the patent, believed himself to be the original and first inventor or dis-

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\* “or” should be “of”.



coverer of the thing patented, the same shall not be held to be void on account of the invention or discovery, or any part thereof, having been known or used in a foreign country, before his invention or discovery thereof, if it had not been patented or described in a printed publication. (R. S. § 4923.)”

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\* It would seem that RS4923 has now become *functus officio* because it had its origin in § 15 of the Patent Act of 1836 (5 Stat. 117), when § 6 of that Act, an antecedent of RS4886, did not contain the words “in this country” after the words “not known or used by others” which were inserted in § 24 of the Patent Act of 1870 (16 Stat. 198). Notwithstanding this Amendment of 1870 to what is now RS4886, § 15 of the Patent Act of 1836 became without substantial change a part of § 62 of the Act of 1870.

RS4923 apparently has not been amended since its incorporation in the Revised Statutes.

Thus it would seem that the words “in this country” in § 24 of the Act of 1870, extended the doctrine of RS4923, which applied to patentees, to everyone without distinction.

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